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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,262	12/15/2003	Junko Sato	00862.023372.	1505

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
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2164

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/734,262

Applicant(s)

SATO ET AL.

Examiner

Sathyanarayan Pannala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's Amendment filed on 10/17/2006 has been entered with amended claims 1,3-6, newly added claims 7-10 and cancelled claim 2. In this Office Action, claims 1, 3-10 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuyama ET AL. (us Patent 5,765,177) hereinafter Nakatsuyama, and in view of Nolan (US Patent 5,933,599) hereinafter Nolan.

4. As per independent claims 1, 5-6, Nakatsuyama teaches the document processing method to perform the processes of retrieve, insertion, composition, and update documents or document parts (col. 3, lines 15-20). Nakatsuyama teaches the claimed, displaying a document structure of a first document file in a display region in a tree structured form (Fig. 2, col. 7, lines 14-16). Nakatsuyama teaches the claimed, inputting an instruction to insert at least one second document file to the first document file displayed in the display region (Fig. 2, col. 7, lines 32-36). Nakatsuyama teaches the claimed, displaying in accordance with the input instruction, a menu dialog of candidates for selecting an insertion method of the second document file in inserting the second document file to the first document file (Fig. 2, col. 7, lines 32-36). Nakatsuyama teaches the claimed, inserting the second document file to the first document file on the basis of the insertion method of the candidate determined in said determining step (Fig. 2, col. 10, lines 31-37). Claim 6 other limitations, Nakatsuyama teaches the claimed, memory unit, input device, display device and processor (Fig. 2, col. 7, lines 8-10).

Nakatsuyama does not teach user drag and drop and menu dialog in windows explorer concept. However, Nolan teaches the claimed, dragging the second document file into an insertion position in the document structure of the first document file,

(Fig. 24, col. 26, lines 45-52). Nolan teaches the claimed, determining which candidate is selected from the candidates in the menu dialog, the menu dialog of the candidates displayed in said displaying step includes at least a first type in which one chapter is newly generated at the insertion position and pages of the second document file are arranged in the newly generated chapter, and a second type in which pages of the second document file are arranged in an existing chapter at the insertion position (Fig. 4-9, col. 9, lines 30-48; col. 10, lines 30-43 and col. 11, lines 11-58). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nolan's teachings would have allowed Nakasuyama's method provides a conventional network shell with user interface for the entire network (col. 1, lines 64-65).

5. As per dependent claim 3, Nakatsuyama teaches the claimed, a document structure type candidate corresponding to at least one of the insertion position and the number of second document files is presented (Fig. 12, col. 19, lines 35-53).

6. As per dependent claim 4, Nakatsuyama teaches the claimed, the document structure includes at least a chapter in an upper layer and a page in a lower layer, a document structure type includes a third type in which chapters are newly generated from the insertion position by the number of second document files and pages of corresponding files are arranged in the generated chapters, a second type in which one chapter is newly generated at the insertion position and pages of the second document

file are arranged in the chapter, and a third type in which pages of the second document file are arranged at the insertion position (Fig. 18-19, col. 25, lines 38-44). Nakatsuyama does not teach user menu dialog in windows explorer concept. However, Nolan teaches the claimed, menu dialog of the candidates displayed (Fig. 4-9, col. 9, lines 30-48; col. 10, lines 30-43 and col. 11, lines 11-58). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nolan's teachings would have allowed Nakasuyama's method provides a conventional network shell with user interface for the entire network (col. 1, lines 64-65).

7. As per dependent claims 7-10, Nakatsuyama does not teach user drag and drop and menu dialog in windows explorer concept. However, Nolan teaches the claimed, dragging the second document file into an insertion position in the document structure of the first document file (Fig. 24, col. 26, lines 45-52). Nolan teaches dealing with menu dialog (Fig. 4-9, col. 9, lines 30-48; col. 10, lines 30-43 and col. 11, lines 11-58). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nolan's teachings would have allowed Nakasuyama's method provides a conventional network shell with user interface for the entire network (col. 1, lines 64-65).

Response to Arguments

8. Applicant's arguments filed on 10/17/2006 with respect to claims 1, 3-10 have been fully considered but they are moot in view the new grounds of rejection.

a) Applicant's argument stated as "Although Nakatsuyama may be seen to disclose that a document part file... (see page 10, paragraph last).

In response to Applicant's argument, Examiner respectfully disagrees because the newly added reference by Nolan does teach the drag and drop and menu dialog. The two references combined do teach all claims and their limitations.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sathyanarayan Pannala
Primary Examiner

srp
December 28, 2006